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EXAMINER

LE, DAVID Q

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 09/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/671,055

Applicant(s)

GAJJALA ET AL.

Examiner

David Q Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Examiner's note

1. The Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claims, other passages and figures apply as well. It is requested from the Applicant, in preparing the response, to consider fully the entire references as well as the context of all references passages as potentially teaching all or part of the claimed inventions.

Status of Claims

2. **Claims 1-66** remain pending.

Response to Request for Consideration

3. Applicant's arguments filed on 30 June 2003 have been fully considered but they are not persuasive.

First, Examiner disagrees with Applicant's argument that specific citations were not used in the 35 USC § 103 rejections of the first Office Action. For example, in regards to claims independent claims 1, 23, and 45, Examiner pointed out specific passages and drawings as well as their associated text to support the analysis of the prior art as it relates to the various limitations in these claims. As each succeeding claim is analyzed and rejected, individual limitations not addressed in that first analysis are appropriately paired with specific citations in the references as well.

Next, Applicant recites almost verbatim the individual limitations of each claim and argues that the references do not suggest nor teach those limitations. Examiner disagrees with all the interpretations of the references as argued by Applicant and respectfully asks that Applicant review all the citations provided in conjunction with each rejection as articulated in the first Office Action and reproduced below.

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Examiner believes that a proper prima facie case has been made for the 35 USC § 103 rejections and that the citations cited amply show that Stefik, Ginter, and Biddle in combination teach all the claimed limitations.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-66** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Stefik et al.**, US Patent 5,634,012, in view of **Ginter et al.**, US Patent 5,892,900, and further in view of **Biddle et al.**, Publication US 2002/0107809 A1 of US Patent Application 09/873,542.

As per **claims 1, 23, 45.**

Stefik discloses a fee accounting mechanism for reporting fees associated with the distribution and use of digital works (Stefik: Abstract; Figs 1-2, associated text; C4, L12-19).

Ginter discloses a Virtual Distribution Environment (VDE) wherein digital property may be distributed via a tightly controlled "chain of distribution and control", from creator to distributor, retailer, license administrator, to user; this VDE system may also incorporate certification authorities, banks and financial institutions, as well as multiple content repositories, all securely communicating with each other over a distributed network. Each communication to and from the nodes of the network comprises a VDE "object", in which content, permissions governing the use of said content, budgets, node identification, transaction identification, and other pertinent information may be incorporated in order to tightly control

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the distribution and use of the content (Ginter: Abstract; Background and Summary of the Invention; Figs 1-5, 78-79, associated text).

Biddle discloses a system for licensing management of digital property wherein a creator/vendor (Applicant's "licensor") may work with a distributor (Applicant's "retailer") to distribute software to users. In order to use this software, the user is required to obtain a license, either directly from the licensor or via the distributor (Biddle: Abstract; Summary of the Invention; Page 3, Par. 17, Figs 1-2, associated text).

Taken individually, none of the three references above specifically discloses all the limitations recited in claims 1, 23, 45. However, it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have combined the teachings of Stefik, Ginter, and Biddle to arrive at a system and method comprising all the limitations of claims 1, 23, and 45. Such a system would provide a secure, trusted method for a retailer to distribute protected digital property to users and control the revenue owed to the retailer, while accurately accounting for the revenue it in turns owes to the creator/licensor of the product. This system would use all the teachings of Stefik, Ginter, and Biddle to create trust and reliance on its security by all parties involved, therefore making it more attractive to all, and would comprise all the limitations of these claims:

A [method, computer having instructions, computer medium with instructions] *for a retailer to facilitate issuance of a digital license from a licensor to a customer for a corresponding piece of digital content, the method comprising* (see all above citations, plus the following ones):

receiving, by the retailer from the customer, payment for the license, the payment to be shared with the licensor in a pre-determined manner;

obtaining, by the retailer from the customer, customer-based information (Stefik: C13, L11-23, L51-58: "repository identifier");

composing, by the retailer, an actual license request including the obtained customer-based information, and including retailer-based information identifying the retailer to the licensor and acknowledging to the licensor that the retailer owes a portion of the received payment to the licensor; and forwarding, by the retailer to the licensor, the actual license request .

As per claims 16, 38, 60.

Using the same citations and motivation analysis as above, it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have combined the teachings of Stefik, Ginter, and Biddle to configure a system meeting all the limitations of these claims. This would have been

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done to allow a licensor to respond to requests for licenses from a user and deliver such licenses, as long as all pertinent authorizations (including payment of fees to an authorized retailer) and permissions for use of the product have been satisfactorily authenticated by the licensor:

A [method, computer having instructions, computer medium with instructions] for a licensor to issue a digital license to a customer for a corresponding piece of digital content, the customer having forwarded payment for the license to a retailer, the payment to be shared with the licensor in a pre-determined manner, the method comprising:

receiving, by the licensor from the retailer, an actual license request as composed by the retailer, the actual license request including customer-based information obtained from the customer, and including retailer-based information identifying the retailer to the licensor and acknowledging to the licensor that the retailer owes a portion of the received payment to the licensor; and

noting, by the licensor, based on the retailer-based information, that the retailer identified thereby owes the licensor at least a portion of the forwarded payment.

As per claims 20, 42, 64.

Using the same citations and motivation analysis as above, it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have combined the teachings of Stefik, Ginter, and Biddle to configure a system meeting all the limitations of these claims. This would ensure that licensors only provide licenses to users that have already paid the proper fees to an authorized retailer, thus protecting the rights of the retailer and the distribution terms previously agreed to between the licensor and retailer:

A [method, computer having instructions, computer medium with instructions] for a licensor to respond to a license request from an individual for a corresponding piece of digital content, the individual having failed to forward payment for the license to a retailer, the method comprising:

receiving, by the licensor from the individual, an actual license request as composed by the individual, the actual license request including customer-based information obtained from the customer, and failing to include retailer-based information identifying a retailer to the licensor and acknowledging to the licensor that a retailer owes a portion of any received payment to the licensor; and

refusing, by the licensor, based on the lack of retailer-based information, to issue a license as requested.

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As per claims 2, 24, 46.

Stefik in view of Ginter and Biddle disclose all the limitations of claims 1, 23, 45.

Both Stefik and Ginter further describe secure environments within their user devices (Stefik: Figs 4b, 12; associated text; Ginter: Fig 6, associated text).

Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have ensured that a system configured to encrypt/decrypt and render the protected digital property distributed should be made tamper proof, so that unauthorized access and use can be prevented. Such a system would then comprise the further limitation of these claims:

... the customer has a digital rights management (DRM) system to ensure that the content is rendered in accordance with the license, the method comprising obtaining the customer based information by a request directed to the DRM system of the customer.

As per claims 3, 25, 47.

Stefik in view of Ginter and Biddle disclose all the limitations of claims 2, 24, 46.

Biddle further discloses downloading a Java applet to manage the interactions between the user system, the licensor, and the retailer (Biddle: Page 11, Par. 93).

Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have incorporated the capability for causing the user DRM system to provide the user information whenever a request for license is made. This would uniquely identify the user to the retailer and provide reliable authentication for the license request:

...obtaining the customer-based information by delivering a controller to the customer that directs the DRM system of the customer to send the customer-based information to the retailer.

As per claims 4, 26, 48.

Stefik in view of Ginter and Biddle disclose all the limitations of claims 1, 23, 45.

None of the cited references disclose utilizing a "dummy package" to obtain user information. However all three references describe transactions between the retailer and user wherein the retailer

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would obtain the user information interactively once a user-generated request for license is made; subsequently the user information is forwarded on to a license server for authentication and license delivery (see all above citations). Therefore it would have been inherent that a system configured as per the teachings of Stefik, Ginter, and Biddle would have the means to effect that procedure. Sending a "dummy package" asking the user system to send back an ID, having that ID delivered to a server controlled by the retailer, where an "actual request" can be created, this time incorporating the retailer's own ID merely allows the retailer to obtain that user information, route it to a server dedicated to authoring license requests for forwarding to a licensor, all of these are processes well known in the art related to distributed processing. As such, Stefik, Ginter, and Biddle in combination meet all the further limitations of these claims:

... the customer has a digital rights management (DRM) system to ensure that the content is rendered in

accordance with the license, wherein obtaining the customer-based information comprises:

delivering, by the retailer to the customer, a dummy package having license acquisition information containing a site identifier for an interposing site controlled by the retailer;

delivering, by the retailer to the customer, a controller that can control the DRM system of the customer, wherein such controller directs such DRM system to send a dummy license request for a license for the dummy package, the dummy license request being directed to the site identifier for the interposing site controlled by the retailer according to the license acquisition information in the dummy package;

and receiving, by the retailer at the interposing site from the customer, the dummy license request including customer-based information, and wherein composing the actual license request comprises modifying, by the retailer, the dummy license request to add the retailer-based information.

As per **claims 5, 27, 49.**

Stefik in view of Ginter and Biddle disclose all the limitations of claims 4, 26, 48.

Both Stefik and Ginter further disclose that their systems allow a retailer/distributor to securely modify digital transmissions in many different ways, so that permissions/requests/authorizations may be changed, as long as the authoring system is allowed to do so (see all above Stefik and Ginter citations). Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to provide the further limitations of these claims, so that (1) the retailer's server knows what content the user is trying to license and (2) the server forwards a correspondingly accurate license request to the

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licensor. Such a method would allow keeping "actual" license identifiers even more secure, thus preventing unauthorized requests from being sent to the licensors directly from the users:

... the dummy license request contains a content ID identifying the dummy package, the method comprising modifying the dummy license request to change the content ID to a content ID identifying an actual package having actual content corresponding to the to-be-issued license.

As per claims 6, 28, 50.

Stefik in view of Ginter and Biddle disclose all the limitations of claims 4, 26, 48.

All three references cited disclose the use of private/public key encryption and user passwords (Applicant's "customer secret" for authentication of user requests (see all above citations). Therefore it would have been obvious for one ordinarily skilled in the art to use one of the "secrets" taught by the references in further securing the authenticity of the request for licensing coming from a potential customer:

... receiving the dummy license request including customer information comprising a customer secret.

As per claims 7, 29, 51.

Stefik in view of Ginter and Biddle disclose all the limitations of claims 4, 26, 48.

Ginter further discloses that his VDE object may include programming code in the permissions records that will be executed ("played") as part of the authorization/authentication process (see Ginter references cited above). Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to incorporate such an application in a transmission from a retailer to a user, thus causing an automatic response from the user system for a request for license to be created and returned. This would negate the need for any intervention from the user, making the system more secure and attractive:

... delivering a controller that directs the DRM system to send a license request for the dummy package by commanding that the dummy package be played.

As per claims 8, 30, 52.

Stefik in view of Ginter and Biddle disclose all the limitations of claims 4, 26, 48.

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Biddle further discloses that executable applets may be downloaded to the user's system to effect actions required for the continued transaction between retailer, user, and licensor (see claim 3 above). Using the same obviousness and motivation analysis as claims 3 and 7 above, the combined references therefore meet the further limitations of these claims:

... delivering the controller comprises downloading such controller to the customer.

As per claims 9, 31, 53.

Stefik in view of Ginter and Biddle disclose all the limitations of claims 8, 30, 52.

Biddle further discloses that the applet may be delivered via a Web page (see Biddle citation used in claim 3 above) . It would have been obvious to one ordinarily skilled in the art at the time the invention was made to include this feature, in order to take advantage of the continued growth and popularity of the Internet for the delivery of digital content:

... delivering the controller comprises downloading such controller to the customer as part of a page such as an HTML web page.

As per claims 10, 32, 54.

Stefik in view of Ginter and Biddle disclose all the limitations of claims 4, 26, 48.

Biddle further discloses that "demonstration" licenses may be used to provide an incentive for users to try out or sample a digital content (Biddle: Page 7, Par 67). Therefore it would have been obvious to one ordinarily skilled in the art to include this feature in order to create a pleasant, attractive incentive for a user who's on the verge of ordering a license for a new product, without giving away too much of the product itself:

... delivering, to the customer, a dummy package having no substantial content therein.

As per claims 11, 33, 55.

Stefik in view of Ginter and Biddle disclose all the limitations of claims 4, 26, 48.

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Biddle further discloses the use of demo licenses (see above claims). It would have been obvious to one ordinarily skilled in the art at the time the invention was made to use such a dummy license request in case a corresponding license is not available yet, i.e. the product has not been finalized. The customer may still send in a request for a full license, which will be delivered at a later date; this way, the customer may pre-order or reserve the product now, thus improving the chance of getting the sale for the product:

...delivering, to the customer, a dummy package having no corresponding license, wherein the sending of the dummy license request results at least in part from the lack of a corresponding license.

As per claims 12, 34, 56.

Stefik in view of Ginter and Biddle disclose all the limitations of claims 1, 23, 45.

All three references further disclose that licenses may be obtained from servers belonging to licensors (see all above citations). Therefore forwarding the license request to a licensor would be inherently comprise:

... forwarding the actual license request to a license server.

As per claims 13, 18, 35, 40, 57, 62.

Stefik in view of Ginter and Biddle disclose all the limitations of claims 1, 16, 23, 38, 45, 60.

All three references further disclose that communications from each participant in their systems require the participant's unique ID (see all above citations). Therefore it would have been obvious for one ordinarily skilled in the art at the time the invention was made to ensure that a retailer's ID would be included in any request for product licensing, for proper authorization, authentication, and accounting:

...composing the actual license request to include retailer-based information comprising a retailer ID identifying the retailer.

As per claims 14, 19, 36, 41, 58, 63.

Stefik in view of Ginter and Biddle disclose all the limitations of claims 1, 16, 23, 38, 45, 60.

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All three references further disclose using public/private key encryption systems to authenticate each participant in their systems. Biddle further discloses that a distributor/retailer may be the one authorizing a creator/vendor to license products to be distributed by the distributor/retailer (see all above citations). Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have incorporated in the license request a retailer's "secret", so that only with an authorization from that retailer would a licensor deliver the requested license:

.. composing the actual license request to include retailer-based information comprising a secret that proves to the licensor that the retailer actually authorized issuance of a license by such licensor.

As per **claims 15, 37, 59.**

Stefik in view of Ginter and Biddle disclose all the limitations of claims 1, 23, 45.

Biddle further discloses that the user may select different features or content (Biddle: Figs 22, 25, associated text; Page 7-8, Par. 71). Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have included this feature, to make the service more attractive to the user by providing choices of content to license:

... comprising receiving, from the customer, a selection of the content.

As per **claims 17, 39, 61.**

Stefik in view of Ginter and Biddle disclose all the limitations of claims 16, 38, 60.

All three references further disclose that communications from each participant in their systems require the participant's unique ID (see all above citations). Therefore it would have been obvious for one ordinarily skilled in the art at the time the invention was made to ensure that a customer's ID would be included in any request for product licensing, for proper authorization, authentication, and accounting:

... preparing the license based on the customer-based information and issuing the prepared license to the customer.

As per **claims 21, 43, 65.**

Stefik in view of Ginter and Biddle disclose all the limitations of claims 20, 42, 64.

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None of the references cited specifically disclose having a licensing server directing a user to a retailer for payment of a license. However Ginter does describe how his VDE system may refer a content requester to another site, at a different location (Ginter: Fig 5A, C59, L17-23). Biddle further discloses that in a situation where a requester does not have an established account, his system will prompt the user for creating a new account (Biddle: Fig 20, associated text). Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made that a referral or re-direction feature would have been desirable at a license server, so that a user that attempt to purchase a license directly from a vendor/creator/licensor may be directed to an authorized retailer in order to pay for such product and obtain a license for it from that retailer. Such a feature would avoid losing potential customers, and create goodwill by saving the customer the step of looking for a retailer:

... comprising directing the individual to a retailer to forward payment for a license.

As per claims 22, 44, 66.

Stefik in view of Ginter and Biddle disclose all the limitations of claims 20, 42, 64.

Biddle further discloses that "demonstration" licenses may be used to provide an incentive for users to try out or sample a digital content (Biddle: Page 7, Par 67). Therefore it would have been obvious to one ordinarily skilled in the art to include this feature in order to create goodwill, as well as attempt to preserve the potential customer's interest, by providing a product sampler or a limited license, while referring the requestor to an appropriate retailer:

... comprising issuing, to the individual, a relatively restrictive license as compared to the license requested.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date

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of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q Le whose telephone number is 703-305-4567. The examiner can normally be reached on 8:30am-5:30pm Mo-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

DQL



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